

Amendments to the Drawings:

Figure 3 amended to change the OP SYS element callout to "352" from "350" which was a duplicate element number.

REMARKS/ARGUMENTS

35 U.S.C. 101 Rejection

Examiner has rejected claims 1 - 6 as being directed to non-statutory subject matter. Applicant respectfully asks examiner to reconsider this rejection in light of the *Ex parte CARL A. LUNDGREN* decision. This decision will effect new claims 8 and 9.

Appeal No. 2003-2088

Application 08/093,516

Regardless of this decision Applicant has rewritten the claims using technology terminology "A computer implemented system" in the claim preamble. This terminology is well supported in the description and the drawings of this application.

35 U.S.C. 103

Examiner has rejected claims 2-4 under 35 USC §102(b) as being anticipated by Brinkman et al. (US 6,697,783). Applicant has amended the claims to particularly point out the novel aspects of the present invention. To wit: "prioritizing, sequencing and grouping the potential actions".

Applicant has defined "prioritizing, sequencing and grouping the potential actions" in the specification on Page 66 Paragraph [0192] Line 11 of paragraph as: "...use a set cost-effectiveness threshold to decide which if any to initiate, and prioritize and sequence the activities which are to be initiated".

MPEP §608.01(o) ("..the meaning of the terms in the claims may be ascertainable by reference to the description")

Examiner has compared these elements to Brinkman ('783) with Official Notice taken that " it is common practice in the medical art that, in order to treat a medical condition, a description of the symptoms must be obtained in order to diagnosis (sic) and treat said medical condition. A series of actions are performed in a sequential (and prioritized) order (obtaining background medical history, obtaining vital health

information {heart rate, pulse, etc.}, examination by a doctor, diagnosis, prescription of treatment, etc.) in the execution of this practice.

Applicant's invention is concerned with influencing those health care professionals involved in selecting prescriptive medicines and cost effectively marketing those prescriptive medicines to those health care professions. Brinkman's disclosure is directed toward and related to : "a computer implemented and/or assisted health information system for tracking and/or ensuring appropriate patient care..." Col. 1 Line 9-15.

The Federal Circuit stated In re Clay, 966 F.2d 656, 23 USPQ 2d 1058, 1060 -61 (Fed. Cir. 1992):

"[a] reference is reasonably pertinent if...it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problemIf a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem....[I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it."

Applicants respectfully submit that a Section 103 (a) obviousness rejection requires some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references. The USPTO Board of Appeals has stated in Ex parte Skinner, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1987):

"When the incentive to combine the teachings of the reference is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper....Absent such reasons or incentives , the teachings of the references are not combinable."

The USPTO Board of Appeals has also stated in Ex parte Levingood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound reasoning does not afford the basis of an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching, in either the prior art or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

As the Federal Circuit has stated in *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, USPQ 2d 1596, 1600 (Fed. Cir. 1988)):

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ' [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention'."

Applicant respectfully submits that in the prior art cited by the examiner does not reference a cost effectiveness criteria to determine if further actions should be taken pertaining to health care product communications.

Conclusion:

The new claims 8-11 specifically points out and claims the novel invention by using a criteria of "cost-effectiveness" as a 'gate' to determine if any further action should be taken to initiate any further activity.

For all the reasons advanced above, Applicant respectfully submits that the amended claims in the application put it in condition for allowance and that action is earnestly solicited.

Respectfully submitted,



James L. Davison

Reg. Number 40,334

NW Patent Group
19822 226th Ave NE
Woodinville, WA 98077
Ph. 425.844.6422
Fax 425.732.0250

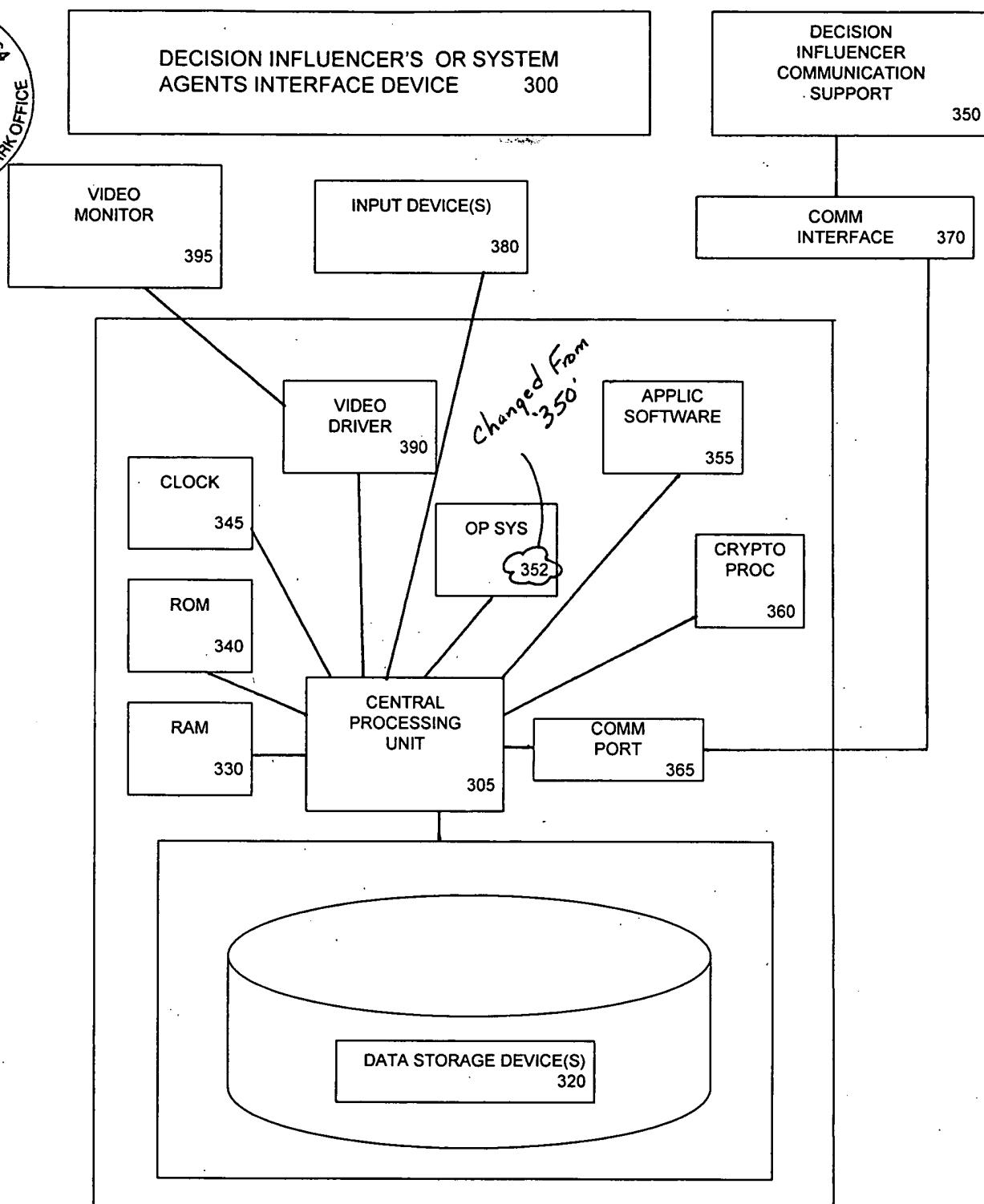


Figure 3